



PATENT
P56559PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: LOUIS LAGLER *et al.*

U.S. Serial No.: 09/890,154

Examiner : HYLTON, R. ANNETTE

U.S. Filing Date: 23 October 2001

Art Unit : 3727

I. A. No.: PCT/CH99/00510

I.A. Filing date: 30 October 1999

Priority date: 27 January 1999

For: CLOSED INJECTION MOULDED CLOSURE PROVIDING MATING UPPER
AND LOWER PARTS COUPLED BY INTEGRALLY FORMED HINGE
CONNECTIONS (as amended)

PETITION UNDER 37 CFR §1.144

Paper No. 21

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully petitions from a finality of a restriction requirement (Paper No. 15) dated April 13, 2004 and made final in Paper No. 20050110 dated January 12, 2005 in response to Applicants' request for withdrawal of the restriction requirement under 37 C.F.R. § 1.143 filed on October 13, 2004.

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I.D.: REB/JHP/ny

STATEMENT OF FACTS

1. Applicants filed a national phase application under 35 U.S.C. §371 of PCT international Application PCT/CH/99/00510 on 27 July 2001.
2. Applicant filed the response in response to the Office action (Paper No. 8) on September 23, 2003. In the response, the applicant added a new claims 21 through 46.
3. A restriction requirement (Paper No. 15) was mailed to Applicants on April 13, 2004 restricting Applicants' invention between product claims and process claims. In this office action, the Examiner withdrew claims 35-37 and 44-46 from consideration, and the Examiner reasoned, without citing any PCT Article or rule, that the product as claimed can be made by another materially different process," and that "[s]ince applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits."
3. On October 13, 2004, Applicants traversed the examiner's restriction on the basis of PCT Article and rules, and the reconsideration was requested.
4. The final Office action (Paper No. 20050110) was mailed to Applicant on January 12,

2005. In this Office action, the Examiner acknowledged the timely traversal of the restriction requirement, and declared that the restriction is Final. In this office action (Paper No. 20050110), the examiner did not cite any PCT rule or Article, either.

REMARKS

The Examiner asserted that newly submitted claims 35-37 and 44-46 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the process of forming the closure was not previously set forth in the claims, and moreover, a different process can be used to mold the closure wherein the closure parts can be molded separately and then secured together or the closure can be molded in an open position.

Applicant traverses this imposition of a requirement for restriction for the following reasons.

This application is a national stage application of the PCT application.

MPEP §1850 states that:

“Any international application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (PCT Article 3(4)(iii) and 17(3)(a), PCT Rule 3.1, and 37 CFR 1.475). Observance of this requirement is checked by the International Searching Authority and may be relevant in the national (or regional) phase. The decision in *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D. Va. 1986) held that the Patent and Trademark Office interpretation of 37 CFR 1.141(b)(2) as applied to unity of invention determinations in international applications was not in accordance with the Patent Cooperation Treaty and its implementing regulations. In the Caterpillar international application, the USPTO acting as an International Searching Authority, had held lack of unity of invention between a set of claims directed to a process for forming a sprocket and a set of claims drawn to an apparatus (die) for forging a sprocket. The court stated that it was an unreasonable interpretation to say that the expression "specifically designed" as found in former PCT Rule 13.2(ii) means that the process and apparatus have unity of invention if they can only be used with each other, as was set forth in MPEP § 806.05(e).

Therefore, when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111. No change

was made in restriction practice in United States national applications filed under 35 U.S.C. 111 outside the PCT.

In applying PCT Rule 13.2 to international applications as an International Searching Authority, an International Preliminary Examining Authority and to national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2.”

First, the examiner’s restriction requirement is not in accordance with the Patent Cooperation Treaty and its implementing regulations.

The Examiner cited 37 CFR 1.142(b) and MPEP §821.03 for the restriction requirement without considering the unity of invention. That is, the Examiner’s test is not proper under the PCT rule.

As MPEP stated, PCT Rule 13.2, as it was modified effective July 1, 1992, no longer specifies the combinations of categories of invention which are considered to have unity of invention. Also, the consideration of unity of invention of claims of different categories should be made without regard to the practice in national applications filed under 35 U.S.C. 111.

Nonetheless, the Examiner did not consider whether the pending claims have unity of invention, and did conclude that the restriction is required merely because the product *as claimed* can be made by another different process. The Examiner’s reasoning is clearly reversed by *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D. Va. 1986). (The court stated that it was an unreasonable interpretation to say ... that the process and apparatus have unity of invention if they can only be used with each other, as was set forth in MPEP § 806.05(e).) (See also MPEP §1850.). Under the PCT rule, as long as there is unity of invention,

the Examiner should consider all the claims.

Even if the applicant requested the examiner to consider whether the requirement of unity of invention is satisfied, the examiner disregarded the proper test for unity of invention and made the restriction requirement final.

Since the examiner did not properly consider the unity of invention, the examiner's restriction requirement is not proper.

Second, there is a technical relationship between the product claims and the process claims.

As stated above, the proper test for "unity of invention" is whether there is a technical relationship among the claimed inventions involving one or more special technical features.

MPEP §1850 further states that:

"Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. The determination is made based on the contents of the claims as interpreted in light of the description and drawings." (Emphasis added)

Here, as recited in the last line of claims 35 and 44, the product made by the process claims 35-37 and 44-46 are directed to the closed injection molded closure. Also, the contents of the claims as interpreted in light of the description and drawings show the required technical relationship. Particularly, most of the features in claims 35-37 and 44-46 are actually recited in the product claims. Therefore, both the products of claims 1-4, 6-34, and 38-43 and the products made by the process claims 35-37 and 44-46 have the common special technical feature of a closed injection molded closure.

Nonetheless, the examiner merely argued that, since the original claims did not include the process claims, and, the invention has been constructively elected by original prosecution for prosecution on the merits. There arguments may be valid at most only where the Examiner decided that there is no unity of invention between the claimed inventions. If the Examiner did not consider the unity of invention under PCT rules, and the unity of invention actually exists, the Examiner should not withdraw claims 35-37 and 44-46 from consideration.

Since there is unity of invention, the Examiner's assertion is not proper.


RELIEF REQUESTED

Accordingly, the Commissioner is respectfully requested to:

Therefore, in view of the foregoing, the Commissioner is respectfully requested to:

1. Withdraw the Restriction requirements;
2. Provide a non-final Office Action on the merits with respect to claims 35-37 and 44-46; and
3. Grant Applicants such other and further relief as justice may require.

Respectfully submitted,



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